UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,483	01/24/2007	Young-Joo Song	CU-4835 WWP	4207

26530   7590   06/22/2011
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EXAMINER
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ART UNIT	PAPER NUMBER
2441	

MAIL DATE	DELIVERY MODE
06/22/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)	
Office Action Summary	10/580,483	SONG ET AL.	
	Examiner	Art Unit	
	NICHOLAS TAYLOR	2441	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>14 April 2011</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>59-90</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>59-90</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>24 May 2006</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☒ All b) ☐ Some * c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>2/9/11</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 59-90 have been presented for examination and are rejected.

Response to Arguments

2.   Applicant's arguments filed April 14th, 2011, with respect to the claims have been
considered but are moot in view of the new grounds of rejection.

Double Patenting

3.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ
644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4.   Claims 59-90 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 45-105 of copending Application No. 10/580,290. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

The instant application	Application No. 10/580,290
59. An apparatus for requesting a report on an event for an Event Reporting on the event that occurs in accordance with use of a digital item, the apparatus comprising:	45. An Event Reporting system for processing an Event Report data in order to report an Event occurred in accordance with use of a digital item, the Event Report system comprising:
an ERR generation means for generating an Event Report Request(ERR) data in response to at least one of a user's request and a received ERR data, the user's request	Event Report Request processing means for generating and delivering an Event Report Request data requesting to report an Event in response to user's request; and

and the received ERR data requesting an Event Report(ER) data for the Event Reporting;	
an ERR transmission means for transmitting the ERR data generated in the ERR generation means; an ERR receiving means for receiving the received ERR data; and an ERR analyzing means for analyzing the ERR data received in the ERR receiving means, wherein the ERR data includes: ERR descriptor information describing characteristics of the ERR data; ER descriptor information describing characteristics of ER data generated based on the ERR data; and Event condition descriptor information describing conditions of occurrence of the event, and wherein the ER data includes: ER descriptor information describing characteristics of the ER data; Original ERR information describing ERR data requesting to generate the ER data; and payload information including reporting information of the ER data.	Event Report processing means for generating and delivering an Event Report data reporting the Event specified in the Event Report Request data.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent therefor,
> subject to the conditions and requirements of this title.

6.   Claims 59-90 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

        As per claims 59-90, the "apparatus" claims are not a process, machine,

manufacture, or composition of matter. The claimed element's "apparatus," "data,"

"descriptor information," etc., are non-structural limitations, and in light of the

specification these are disclosed as being software (e.g., see Spec pg. 8, lines 6-16

defined as an application program). Therefore, the claimed subject matter as a whole

fails to fall within a patent-eligible category of subject matter.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a
> printed publication in this or a foreign country, before the invention thereof by the applicant for a
> patent.

8.   Claims 59-90 are rejected under 35 U.S.C. 102(a) as being anticipated by

"Requirements for Event Reporting" by the ISO WG11 Requirements Group (hereafter

referred to as "WG11", and further incorporating WG11's "Current Vision on Event

Reporting in MPEG 21," hereafter, "Vision," for clarity and background).

As per claims, 59 and 75, WG11 teaches an apparatus for processing a report on an

event for an Event Reporting on the event that occurs in accordance with use of a digital

item, the apparatus comprising:

a monitoring means for monitoring whether or not the event occurs;

an ER generation means for generating an Event Report(ER) data for an event report

corresponding to an Event Report Request(ERR) data requesting the report on the

event; and (WG11, sections 2, 3.1, 4.1 and "Vision" section 3.1-3.3 where events are

monitored and event generation occurs)

an ER transmission means for transmitting the ER data generated in the ER

generation means, (WG11, sections 2, 3.1, 4.1 where ER data is transmitted)

wherein the ERR data includes: ERR descriptor information describing

characteristics of the ERR data; ER descriptor information describing characteristics of

ER data generated based on the ERR data; and Event condition descriptor information

describing conditions of occurrence of the event, and (WG11, sections 2, 3.1, 4.1 and

"Vision" section 3.1-3.3; see also Visions appendix B use case scenario; see also, e.g.,

section 7 requirements 1.1, 1.5, 2.1, and 2.3)

wherein the ER data includes: ER descriptor information describing

characteristics of the ER data; Original ERR information describing ERR data

requesting to generate the ER data; and payload information including reporting

information of the ER data (WG11, sections 4.0, 4.1, and 4.2, where the descriptor is

further defined; see e.g., section 7 requirements 1.1, 1.5, 2.1, and 2.3).

As per claims 60 and 76, WG11 teaches the system further wherein the ERR descriptor information includes life time information describing a life time of the ERR data (WG11, see, e.g., section 7 requirements 2.9 and 2.20).

As per claims 61 and 77, WG11 teaches the system further wherein the ERR descriptor information includes history information describing a history of creation or modification of the ERR data (WG11, see, e.g., section 7 requirements 2.15 and 3.10).

As per claims 62 and 78, WG11 teaches the system further wherein the ERR descriptor information includes priority level information describing priority level for processing the ERR data (WG11, see section 7 requirement 2.13).

As per claims 63 and 79, WG11 teaches the system further wherein the ER descriptor information includes identification information of the ER data (WG11, see, e.g., section 7 requirements 2.1, 2.2, 2.3, and 2.5, where identification information is defined).

As per claims 64 and 80, WG11 teaches the system further wherein the ER descriptor information includes ER access control information describing information on a peer or a user that can access to the ER data (WG11, section 7 requirements access provisions 3.11 and 3.12).

As per claims 65 and 81, WG11 teaches the system further wherein the ER descriptor

information includes ER format information describing information on a format of the ER

data (WG11, section 7 requirements 2.8, 2.9, 2.10, and 3.15).

As per claims 66 and 82, WG11 teaches the system further wherein the ER descriptor

information includes embedded ERR information describing information on another

ERR data included in the ER data (WG11, see section 7 requirement 3.8 embedding).

As per claims 67 and 83, WG11 teaches the system further wherein the ER descriptor

information includes at least one of identification information of a peer generating the

ER data, identification information of a user generating the ER data, information on time

when the event occurs and information on location of the peer (WG11, see, e.g., section

7 requirements 2.15 and 3.10).

As per claims 68 and 84, WG11 teaches the system further wherein the ER descriptor

information includes delivery parameter information describing information on delivery of

the ER data (WG11, section 7 requirements 2.8, 2.9, 2.10, and 3.15).

As per claims 69 and 85, WG11 teaches the system further wherein the Event condition

descriptor information includes time condition information describing occurrence time of

the event (WG11, section 7 requirements 2.8, 2.9, 2.10, and 3.15).

As per claims 70 and 86, WG11 teaches the system further wherein the Event condition descriptor information includes condition information other than time condition information describing occurrence time of the event (WG11, section 7 requirements 2.8, 2.9, 2.10, and 3.15).

As per claims 71 and 87, WG11 teaches the system further wherein the Event condition descriptor information is represented by a combination of time condition information describing occurrence time of the event and condition information other than the time condition information (WG11, section 7 requirements 2.8, 2.9, 2.10, and 3.15).

As per claims 72 and 88, WG11 teaches the system further wherein the ER data further includes embedded ERR information describing information on another ERR data included in the ER data (WG11, see section 7 requirement 3.8 embedding).

As per claims 73 and 89, WG11 teaches the system further wherein the ER descriptor information includes status information describing whether generation of the ER data is completed and creation information describing information related to generation of the ER data (WG11, see section 7 requirements 3.14, 3.15 and 4; see also peer discussion of section 2, 3.1, and diagram 3.2; section 6 peer status-based events; see section 7 requirement 1.2).

As per claims 74 and 90, WG11 teaches the system further wherein the ER descriptor
information further includes description information describing information related to the
ER data in a free form (WG11, see, e.g., section 7 requirements 1.5 and 1.6 where the
data is described in a free form).

Conclusion

9.   Applicant's amendment necessitated any new grounds of rejection presented in
this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37
CFR 1.136(a).

        A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed within
TWO MONTHS of the mailing date of this final action and the advisory action is not
mailed until after the end of the THREE-MONTH shortened statutory period, then the
shortened statutory period will expire on the date the advisory action is mailed, and any
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of
the advisory action. In no event, however, will the statutory period for reply expire later
than SIX MONTHS from the date of this final action.

        Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-
3889. The examiner can normally be reached on Monday-Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Wing Chan can be reached on (571) 272-7493. The fax phone number for

the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

/NT/
Nicholas Taylor
Examiner
Art Unit 2441

/Larry Donaghue/
Primary Examiner, Art Unit 2454